

REMARKS

In the outstanding Office Action, claims 1-20 are rejected in view of prior art, and the title and claims 1 and 18 are objected to for formal matters. By this Amendment, claims 1-20 remain substantially as filed, with changes to claims 1 and 18 being made only as nonnarrowing amendments to clarify and overcome the objections for formal matters. Arguments traversing the rejections are presented along with new claims 21-23. Thus, this Amendment leaves claims 1-23 pending in the application with claims 1, 13 and 21 being independent claims. Reconsideration and allowance of the pending claims are respectfully requested.

Specification

In paragraph 2 of the Office Action, the title is indicated as being nondescriptive. In response, the title has been amended as set forth herein to be more descriptive. Accordingly, withdrawal of the objection to the title is respectfully requested.

Claim Objections

In paragraph 3 of the Office Action, claims 1 and 18 are objected to for informalities. In response, claims 1 and 18 have been amended as set forth herein to correct the noted informalities. The changes to claims 1 and 18 are merely clarifying changes and are not narrowing amendments. Accordingly, withdrawal of the objection to the claims is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

In paragraphs 5 and 7 of the Office Action, claims 1, 2, 5-9 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beringer in view of Jewell. This rejection is respectfully traversed since the two references are not properly combinable and since even if properly combinable, the resulting structure does not satisfy the claim limitations.

The Office Action states that Beringer does not disclose a first scale as claimed, but states that Jewell teaches a ruler with a scale having a “lower surface (column 1, lines 30-33) being rigidly and unreleasably attached to said first scale supporting section.” However, Jewell does not teach a ruler as suggested by the Office Action.

Instead, Jewell discloses a ruler that “consists of a thin pliable sheet” that “may be punched in a single piece from sheet-steel or other material, or its parts may be made

separately and rigidly united in the form show” (col. 1, lines 25-33). Thus, if the ruler of Jewell is not formed as one-piece, it is formed as a series of flat, one-piece members as illustrated in Fig. 1, which shows each scale “a” as being one-piece with two separate end pieces connecting the two scales “a.”

Meanwhile, each of claims 1 and 13 also states that the first scale has a “lower surface” that is “attached to said scale-supporting section.” The lower surface of the scale “a” of Jewell is not attached to anything, and is certainly *not* attached to a scale-supporting section that is “coupled to and extending along said upstanding section” as set forth in claim 1 or attached to “an inclined scale-supporting section” as set forth in claim 13. Thus, the Office Action’s interpretation of Jewell is inaccurate.

Additionally, there is no motivation to combine the two references. The Office Action states that the motivation for the proposed combination is “to include an elongated first scale and a contact surface, as taught by Jewell, so as to provide additional measuring units so as to increase the capacity of measurements during use of the device.” This motivation is not supported in the prior art and, further, is inadequate. First, Bearinger already has an elongated scale. In fact, Bearinger has two elongated scales; one with inches and one with centimeters (col. 2, lines 15-21) and neither reference suggests that a third or any additional scales are desired or needed. Second, Bearinger already has two contact surfaces 8 (col. 2, lines 3-6) and neither reference suggests a third or any additional contact surfaces.

Thus, neither reference discloses or suggests attaching the lower surface of a scale to a scale supporting surface. Accordingly, there is no motivation, absent improper hindsight reasoning, to combine the references as proposed in the Office Action.

Additionally, even if the two references were properly combinable, the resulting structure would not result in the apparatus as claimed. The Office Action admits that Bearinger does not disclose a lower surface of a scale attached to a scale supporting surface and as explained herein, Jewell also does not disclose or suggest a lower scale surface attached to a scale supporting surface. Accordingly, any proper combination of the two references must result in a structure *without* a lower scale surface attached to a scale supporting surface.

Since the prior art of record neither discloses nor suggests the claimed invention, claims 1 and 13 are allowable and withdrawal of the rejection is respectfully requested.

Claims 2-12 and 14-20 depend from and further limit either claim 1 or claim 13 and are allowable over the prior art of record at least for the reasons set forth above with respect to claims 1 and 13.

Also, the dependent claims contain subject matter that is additionally not disclosed or suggested in the prior art of record. For example, claims 7 and 18 state that the contact or bottom surface, respectively, “includes second indicia.” Jewell does state that its ruler can be “used either side up” (col. 2, line 68), but there is no motivation to combine this feature with the paper holder of Bearinger. In fact, if one was to locate indicia on the bottom of the paper holder of Bearinger to use the bottom of the holder, the intended use of the paper holder would be destroyed since the slot 30 for holding the paper would not be usable. Thus, not only is there no motivation to combine the references to provide indicia on the bottom or contact surface of the holder of Bearinger, but Bearinger *teaches away from* such a combination.

Another example can be found in claim 14, which states that “said finger resting surface is substantially parallel to said first bottom surface.” The Office Action states that Bearinger discloses this feature in Fig. 3 and states that the bottom surface of Bearinger’s holder is the flat supporting surface 8. However, each of the upper surfaces 14 of Bearinger are “inclined...and hence located at a slight angle with respect to the flat supporting surfaces 8” (col. 2, lines 15-18). Thus, the prior art neither discloses nor suggests, finger resting surfaces substantially parallel to the first bottom surface, as claimed.

A further example can be found in claim 20, which recites that “said upstanding section includes means for gripping said upstanding section by fingers of a user of said guiding device.” Since claim 20 invokes 35 USC § 112, 6th paragraph, this means-plus-function limitation includes the structure disclosed in the specification as performing the function and its equivalents. A means for gripping disclosed in the specification includes ribs attached to the upstanding section. An example of these ribs is disclosed as ribs 39 (Specification at page 5, lines 11-14), which are illustrated in Fig. 3A. However, neither Bearinger nor Jewell disclose or suggest such ribs for gripping an upstanding section.

In paragraph 6, claims 3, 4, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bearinger in view of Jewell and further in view of Syed (GB 2180799A). Since claims 3, 4, 10 and 11 depend from and further limit claim 1 and since Syed fails to provide for all of the deficiencies of Bearinger and Jewell as set forth above, claims 3, 4, 10 and 11 are deemed allowable at least for the reasons set forth above with respect to claim 1.

New Claims

New claims 21-23 are added to define additional aspects of the claimed invention and the embodiments illustrated in the subject application.

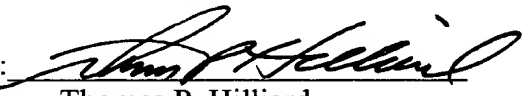
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In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached Appendix is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,
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Enclosure: Appendix

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE ✓

IN THE TITLE:

Please replace the title with the following new title:

-- STRAIGHT EDGE TO FACILITATE HOLDING AND MEASURING AND TO PROVIDE PROTECTION WHEN CUTTING --

IN THE CLAIMS:

Please replace originally-filed claims 1 and 18 with new claims 1 and 18, as follows:

1. (Amended) A [An] guiding device, comprising:

an elongated finger-resting surface;

an elongated upstanding section projecting upwardly from said finger-resting surface;

an elongated scale-supporting section coupled to and extending along said upstanding section with said upstanding section being positioned between said [first] scale-supporting section and said finger-resting surface, said scale-supporting section being inclined with respect to a guiding device supporting surface; and

an elongated first scale made of metal and having a lower surface and an upper surface, said lower surface being rigidly and unreleasably attached to said [first] scale-supporting section and said upper surface having first indicia to indicate predetermined lengths along said first scale, and

said finger-resting surface permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement by said upstanding section during movement of the implement along said guiding device adjacent said first scale.

18. (Amended) A guiding device according to claim 13, wherein

said bottom surface includes second indicia indicating predetermined lengths along said [contact] bottom surface.

End of Appendix.